REMARKS

Favorable reconsideration of this application is respectfully requested in view of the following remarks. Claims 1-38 are currently pending in the present application of which Claims 1, 12, 21 and 30 are independent.

Improper Final Rejection

Applicants respectfully request reconsideration of the decision to make the present Office Action Final and to withdraw the final nature of the present Office Action. As set forth below, U.S. Patent Application Serial No. 2001/0003823 to Mighdoll et al. clearly fails to disclose all of the elements set forth in the claims of the present invention. In this regard, the previous and current Office Actions improperly relied upon the disclosure contained in Mighdoll et al.

In addition, the Official Action contradicts itself by arguing that Mighdoll et al. discloses the elements of Claim 7 of the present invention on page 4 of the Official Action and then stating that "Mighdoll does not teach a means in which page numbers are predetermined or stored" on page 6 of the Official Action. It is not at all understood as to how the Official Action could reject a claim with a document that the Official Action states does not disclose the elements of that claim. Claim 7 states that a predetermined number of recently visited display page numbers is stored, which is clearly what the Official Action states as not being taught in Mighdoll et al.

Accordingly, because Applicants are entitled to a complete prosecution of the present application, the final nature of the present Office Action should be withdrawn.

Claim Rejection Under 35 U.S.C. §103

The test for determining if a claim is rendered obvious by one or more references for purposes of a rejection under 35 U.S.C. § 103 is set forth in MPEP § 706.02(j):

> To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure. *In re Vaeck,* 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

Therefore, if the above-identified criteria are not met, then the cited reference(s) fails to render obvious the claimed invention and, thus, the claimed invention is distinguishable over the cited reference(s).

U.S. Patent Application No. 2001/0003823 to Mighdoll et al.

The Official Action sets forth a rejection of Claims 1-5, 7, 12-14, 20-22, 28-32 and 38 under 35 U.S.C. §103(a) as allegedly being unpatentable over the disclosure contained in Mighdoll et al. This rejection is respectfully traversed because Mighdoll et al. fails to disclose the claimed invention as set forth in Claims 1, 12, 21 and 30.

The Official Action asserts that Mighdoll et al. discloses all of the elements contained in Claims 1, 12, 21, and 30 of the present invention except for what appears to be alleged differences in nomenclature. Applicants respectfully disagree with this assertion.

Initially, it is important to point out that the differences between the claimed invention and the disclosure of Mighdoll et al. are not merely differences in nomenclature but are also

differences structure and function. An exemplary distinction is that Mighdoll et al. does not disclose a "number-of-pages-to-be-loaded variable storage area" as set forth in Claim 1 nor the step of "obtaining a predetermined number-of-pages-to-be-loaded variable" as set forth in Claims 12, 21, and 30. As stated at least in paragraph 23, page 7, of the specification, the "number-of-pages-to-be-loaded variable storage area 138 is the variable N, and controls how many pages are loaded into the display pages storage area 120.

The Official Action asserts that the partitioning of a document into a plurality of partitions disclosure in Mighdoll et al. somehow reads on the "number-of-pages-to-be-loaded variable storage area". Presumably, the Official Action is relying on the disclosure contained in paragraphs 41 and 42, on page 3, or in paragraphs 106-107, on pages 7-8, of the Mighdoll et al. document to reach this conclusion. However, upon close inspection of the disclosure contained in those paragraphs of Mighdoll et al., it is evident that clear distinctions from the claims of the present invention exist.

In paragraph 42, Mighdoll et al. discloses the basic purpose of a document database 61. More particularly, Mighdoll et al. discloses that the document database 61 operates to speed up processing and downloading of that document in response to all future requests for that document after that document has initially been retrieved. In addition, that paragraph discusses that the document database 61 stores information for use by the WebTV service.

In paragraph 43, Mighdoll et al. discloses how a server 5 initially receives a document request and the options the server 5 has in retrieving the requested document. For instance, the document may be retrieved from a cache 65 or an appropriate remote server 4. Clearly, therefore, there is nothing in either of paragraphs 42 or 43 that discusses a "number-of-pages-to-be-loaded variable storage area" as set forth in Claim 1 or the step of "obtaining a

predetermined number-of-pages-to-be-loaded variable" as set forth in Claims 12, 21, and 30 of the present invention. In addition, paragraphs 106 and 107 discuss the updating of cached documents and also do not discuss these elements of Claims 1, 12, 21, and 30. The Official Action has, therefore, failed to establish any disclosure in Mighdoll et al. that could be interpreted as reading on the all of the elements claimed in Claims 1, 12, 21, and 30.

In regard to the disclosure of partitions, *per se*, in the Mighdoll et al. document, there is an exemplary reference in the Abstract. As described in the Abstract of Mighdoll et al., the partitions refer to the separation of "Web pages into partitions such that each one of the partitions corresponds to the viewable display area of the television screen coupled to the client." The partitions, therefore, do not pertain to a number of pages, but instead to a single page that has been broken down to enable the page to be sized for viewing on a television screen. This type of partitioning may be necessary in the WebTV environment since most web pages are formatted for viewing on computer screens, whereas, WebTV uses television screens to display the web pages. A clear distinction may thus be seen between the use of partitions and a number-of-pages-to-be-loaded variable storage area, which controls how many pages are loaded into the display pages storage area.

Another distinction between the Mighdoll et al. disclosure and the claims of the present invention is that Mighdoll et al. fails to disclose a "most-likely-to-be-visited pages storage area" as set forth in Claim 1, nor the step of "obtaining stored most-likely-to-be-visited pages information" as set forth in Claims 12, 21, and 30 of the present invention. The most-likely-to-be-visited pages is described at least on page 9, paragraph 33 of the present specification. As stated therein, the most-likely-to-be-visited pages is "based on a statistical analysis of user viewing habits", with an assumption "that the user will initially go through

display pages in sequence." In other words, during an initial visit to a Web page, a user will go through various links in sequence. For instance, a user will visit the homepage first, and will select a link from the homepage, and possibly another link from the second selected page, and so forth. The sequence in which the Web pages are selected may be analyzed and prefetched, for instance, when the user visits the homepage in the future.

In contrast, Mighdoll et al. discloses in paragraphs 109-110, on page 8, that a list of images referenced by a particular document is stored in the document database 61. More particularly, Mighdoll et al. discloses that the list of images provided by the server 5 includes the most popular links, "i.e., those which have previously received a large number of hits". Therefore, Mighdoll et al. discloses that the list of images is based upon popularity and not based upon a sequence of actions by the user. In this regard, Mighdoll et al. fails to disclose the elements contained in Claims 1, 12, 21, and 30 of the present invention.

Mighdoll et al. also fails to disclose elements contained in the claims that depend from Claims 1, 12, 21, and 30. For instance, Claims 2 and 28 of the present invention state that display page processing device includes a processed image storage and that a previously processed and viewed display page is stored in the processed image storage after it is bumped from the display pages storage area. The Official Action asserts that page 3 of Mighdoll et al. discloses these elements. Applicants respectfully disagree with this assertion because, while Mighdoll et al. may disclose the keeping of historical and diagnostic information, the Official Action has failed to indicate that a previously processed and viewed display page is stored in the processed image storage after it is bumped from the display pages storage area.

As another example, Claim 7 of the present invention states that the most-recently-visited pages storage area stores a predetermined number of recently visited display page

numbers and Claim 22 of the present invention states that a predetermined number of recently visited display page numbers are stored to the most-recently-visited pages information. The Official Action asserts that these elements are disclosed on page 7 of Mighdoll et al. on the bases that "Migholl's system stores pages of the last several fetches of a document." Applicants also respectfully disagree with this assertion because, while Mighdoll et al. may disclose the storage of pages of the last several fetches of a document, the Official Action has failed to indicate that a **predetermined** number of recently visited display page numbers are stored.

Furthermore, the Applicants respectfully submit that the rejection under 35 U.S.C. § 103 over Mighdoll et al. is improper because the Official Action fails to provide a motivation for modifying Mighdoll et al. "The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art suggests the desirability of the combination." In re Mills, 916 F. 2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990). Also See MPEP §2143.01. In this case, the Official Action has failed to provide a second reference or any other prior art that would show motivation to modify Mighdoll et al. as suggested in the Official Action. Therefore, the first test of obviousness has not been satisfied.

Even assuming for the sake of argument that the 35 U.S.C. § 103 rejection is considered proper, the Applicants submit that there is no motivation in Mighdoll et al. to modify Mighdoll et al. to achieve the present invention. The Applicants respectfully submit that the motivation to modify a reference to perform a substantially different function not disclosed therein, cannot, by definition, be found within itself. There must be some suggestion or teaching in the prior art to combine or modify a reference. If only a single reference is used, that reference teaches the subject matter of its disclosure and, by definition,

cannot teach a modification of the disclosure to achieve a substantially different function than that intended by the disclosure. Therefore, the Applicants respectfully submit that the Official Action has failed to show a motivation to modify Mighdoll et al.

At least by virtue of Mighdoll et al.'s failure to disclose the above-identified elements of Claims 1, 12, 21 and 30, the Official Action has failed to establish that Claims 1, 12, 21 and 30 of the present invention are rendered obvious under 35 U.S.C. § 103. More particularly, the Official Action has failed to establish a *prima facie* case of obviousness at least because Mighdoll et al. fails to teach or suggest all the claim elements. Accordingly, the Examiner is respectfully requested to withdraw the rejection of Claims 1, 12, 21 and 30.

For at least the foregoing reasons, Claims 1, 12, 21, and 30 are patentably distinguishable over the disclosure contained in Mighdoll et al. The Examiner is therefore respectfully requested to withdraw the rejection of Claims 1, 12, 21 and 30. Claims 2-11 depend from allowable Claim 1, Claims 13-20 depend from allowable Claim 12, Claims 22-29 depend from allowable Claim 21 and Claims 31-38 depend from allowable Claim 30. Therefore, Claims 2-11, 13-20, 22-29 and 31-38 are also allowable over Mighdoll et al. at least by virtue of their dependencies.

Mighdoll et al. in view of WO 02/10943 to Davis

The Official Action sets forth a rejection of Claims 6, 17, 25 and 35 under 35 U.S.C. §103(a) as allegedly being unpatentable over the disclosure contained in Mighdoll et al. in view of Davis. The Applicants respectfully traverse this rejection because Claims 6, 17, 25, and 35 are patentably distinguishable over the disclosures of Mighdoll et al. and Davis, considered either singly or in combination.

It is respectfully submitted that Claims 6, 17, 25, and 35 are allowable over the prior art of record at least by virtue of their dependencies upon allowable independent claims. In addition, the disclosure contained in Davis is not relied upon in the Official Action to make up for the deficiencies in the rejection of Claims 1, 12, 21, and 30 of the present invention. Moreover, even assuming for the sake of argument that the proposed modification of Mighdoll et al. with the disclosure contained in Davis were obvious, such a combination would not yield all of the elements set forth in Claims 6, 17, 25, and 35 as alleged in the Official Action. Therefore, the rejection of Claims 6, 17, 25, and 35 based upon the proposed combination of Mighdoll et al. and Davis is improper and should be withdrawn.

The Examiner is therefore respectfully requested to withdraw the rejection of Claims 6, 17, 25 and 35.

Mighdoll et al. in view of U.S. Patent Application No. 2003/0151651 to Roztocil

The Official Action sets forth a rejection of Claims 8-11, 15, 16, 18, 19, 23-27, and 33-37 under 35 U.S.C. §103(a) as allegedly being unpatentable over the disclosure contained in Mighdoll et al. in view of Roztocil. The Applicants respectfully traverse this rejection because Claims 8-11, 15, 16, 18, 19, 23-27, and 33-37 are patentably distinguishable over the disclosures of Mighdoll et al. and Roztocil, considered either singly or in combination.

It is respectfully submitted that Claims 8-11, 15, 16, 18, 19, 23-27, and 33-37 are allowable over the prior art of record at least by virtue of their dependencies upon allowable independent claims. In addition, the disclosure contained in Roztocil is not relied upon in the Official Action to make up for the deficiencies in the rejection of Claims 1, 12, 21, and 30 of the present invention. Moreover, even assuming for the sake of argument that the proposed

modification of Mighdoll et al. with the disclosure contained in Roztocil were obvious, such a combination would not yield all of the elements set forth in Claims 8-11, 15, 16, 18, 19, 23-27, and 33-37 as alleged in the Official Action. Therefore, the rejection of Claims 8-11, 15, 16, 18, 19, 23-27, and 33-37 based upon the proposed combination of Mighdoll et al. and Roztocil is improper and should be withdrawn.

The Examiner is therefore respectfully requested to withdraw the rejection of Claims 8-11, 15, 16, 18, 19, 23-27, and 33-37.

Conclusion

In light of the foregoing, withdrawal of the rejections of record and allowance of this application are earnestly solicited.

Should the Examiner believe that a telephone conference with the undersigned would assist in resolving any issues pertaining to the allowability of the above-identified application, please contact the undersigned at the telephone number listed below. Please grant any required extensions of time and charge any fees due in connection with this request to deposit account no. 08-2025.

Respectfully submitted,

A. Marie Vans et al.

Dated: June 2, 2004 By

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